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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,891	06/17/2005	Johnathan A Napier	13478-00001-US	7537

23416 7590 11/01/2006

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EXAMINER
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MEAH, MOHAMMAD Y

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/539,891

Applicant(s)

NAPIER ET AL.

Examiner

Mohammad Meah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

## DETAILED ACTION

1. The claims 1-25 are pending in the instant office action.

### ***Restriction***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-9, drawn to a method of producing lipid compounds using transgenic organisms expressing 9-elongase gene of SEQ ID NO: 3 and 8-destaturase gene of SEQ ID NO: 1

Group II, claims 1-9, drawn to a method of producing lipid compounds using transgenic organisms expressing 9-elongase gene of SEQ ID NO: 3, 8-destaturase gene of SEQ ID NO: 1 and 5-destaturase gene of SEQ ID NO: 5.

Group III, claims 1-9, drawn to a method of producing lipid compounds using transgenic organisms expressing 9-elongase gene of SEQ ID NO: 3, 8-destaturase gene of SEQ ID NO: 1 and 5-destaturase gene of SEQ ID NO: 7

Group IV, claims 1-9, drawn to a method of producing lipid compounds using transgenic organisms expressing 9-elongase gene of SEQ ID NO: 3, 8-destaturase gene of SEQ ID NO: 1 and 5-destaturase gene of SEQ ID NO: 9

Group V, claims 10, 13-18, drawn to DNA of 8-destaturase gene of SEQ ID NO: 1, plasmid, vector and transformant containing said DNA.

Group VI, claim 12, drawn to 8-destaturase polypeptide comprising amino acid sequence encoded by DNA of SEQ ID NO: 1.

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Group VII, claims 11, 20-25, drawn to DNA of 5-destaturase gene of SEQ ID NO: 5 plasmid, vector and transformant containing said DNA.

Group VIII, claims 11, 20-25, drawn to DNA of 5-destaturase gene of SEQ ID NO: 7 plasmid, vector and transformant containing said DNA.

Group IX, claims 11, 20-25, drawn to DNA of 5-destaturase gene of SEQ ID NO: 9 plasmid, vector and transformant containing said DNA.

Group X, claim 19, drawn to 5-destaturase polypeptide comprising amino acid sequence encoded by DNA of SEQ ID NO: 5.

Group XI, claim 19, drawn to 5-destaturase polypeptide comprising amino acid sequence encoded by DNA of SEQ ID NO: 7.

Group XII, claim 19, drawn to 5-destaturase polypeptide comprising amino acid sequence encoded by DNA of SEQ ID NO: 9.

3. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and II-IV do not share their technical feature because these method steps use microorganisms expressing different genes having different technical features.

Groups V-XII technical features are different compounds and they do not share same technical feature because each compound has its own technical feature.

While the products of group V are used in the process of group I they do not share same technical feature because these products can be used in other processes having different technical features such as in the process of making protein of group VI.

While the products of groups VII-IX are used in the process of group II-IV respectively they do not share same technical feature because these products can be used in other processes having different technical features such as in processes of making proteins of groups X-XII.

Furthermore; the only technical feature linking group I-XII appears to be that they all relate to transgenic organism that expresses genes of 9-elongase and 8-desaturase. The transgenic organism that expresses genes of 9-elongase and 8-desaturase does not constitute a "special technical feature" as defined by PCT Rule

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13.2, because it does not claim a feature which defines a contribution over the prior art as transgenic organism that expresses genes of 9-elongase and 8- desaturase.is taught by the prior art ( WO 02/077213).

4. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

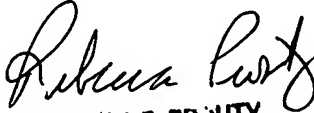
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